



RECEIVED
CENTRAL FAX CENTER

JAN 06 2006

FACSIMILE COVER SHEET

DATE: January 4, 2006

TO: Examiner BAYARD, Djenane M. **FAX NO.:** 571-273-8300
USPTO GPAU 2141

FROM: Jeffrey G. Toler
Reg. No.: 38,342

RE U.S. App. No.: 10/634,116, filed August 4, 2003

Applicant(s): Kenneth R. Jones, et al.

Atty Dkt No.: 1033-SS00379

Title: SYSTEM AND METHOD TO IDENTIFY DEVICES EMPLOYING
POINT-TO-POINT-OVER ETHERNET ENCAPSULATION

NO. OF PAGES (including Cover Sheet):

MESSAGE:

Attached please find:

- Transmittal Form (1 pg)
- Notice of Appeal (in duplicate) (2 pgs)
- Pre-Appeal Brief Request for Review (1 pg)
- Remarks in Support of Pre-Appeal Brief Request for Review (5 pgs)

5000 Plaza On The Lake
Suite 265
AUSTIN, TEXAS 78746

Tel: (512) 327-5515
Fax: (512) 327-5452

CONFIDENTIALITY NOTE

The pages accompanying this facsimile transmission contain information from the law office of Toler, Larson & Abel, L.L.P. and are confidential and privileged. The information is intended to be used by the individual(s) or entity(ies) named on this cover sheet only. If you are not the intended recipient be aware that reading disclosing copying distribution or use of the contents of this transmission is prohibited. Please notify us immediately if you have received this transmission in error at the number listed above and return the document to us via regular mail.

JAN. 6. 2006 11:20AM

TL&A 512-327-5452

RECEIVED
CENTRAL FAX CENTER

NO. 4911 P. 2

JAN 06 2006

PTO/SB/21 (09-04)

Approved for use through 07/31/2006, OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL
FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	10/634,116
Filing Date	August 4, 2003
First Named Inventor	KENNETH R. JONES
Art Unit	2141
Examiner Name	BAYARD, Djeneane M.
Total Number of Pages in This Submission	9
Attorney Docket Number	1033-SS00379

ENCLOSURES (Check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> <input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	<input type="checkbox"/> Pre-Appeal Brief Request for Review (1 pg); and Remarks In Support of Pre-Appeal Brief Request for Review (5 pgs)
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Reply to Missing Parts/ Incomplete Application	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		
CUSTOMER NO.: 34456		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	TOLER, LARSON & ABEL, LLP		
Signature			
Printed name	Jeffrey G. Toler		
Date	1 - 6 - 2006	Reg. No.	38,342

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Grace Adame

Typed or printed name

Grace Adame

Date

Jan. 6, 06

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

JAN. 6. 2006 11:20AM

TL&A 512-327-5452

RECEIVED
CENTRAL FAX CENTER

NO. 4911 P. 5

JAN 06 2006

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through 06/01/2006. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 1033-SS00379
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>January 6, 2006</u></p> <p>Signature <u>Grace Adame</u></p> <p>Typed or printed name <u>Grace Adame</u></p>	Application Number 10/634,116	Filed August 4, 2003
	First Named Inventor Kenneth R. Jones	
	Art Unit 2141	Examiner BAYARD, Djenane M.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.



Signature

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Jeffrey G. Toler

Typed or printed name

attorney or agent of record.

Registration number 38,342

512-327-5515

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

1 - 3 - 1006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

JAN. 6. 2006 11:21AM

TL&A 512-327-5452

RECEIVED
CENTRAL FAX CENTER

NO. 4911 P. 6

JAN 06 2006

CUSTOMER NO.
34456

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Kenneth R. Jones, et al.

Title: SYSTEM AND METHOD TO IDENTIFY DEVICES EMPLOYING
POINT-TO-POINT-OVER ETHERNET ENCAPSULATION

App. No.: 10/634,116 Filed: August 4, 2003

Examiner: BAYARD, Djenane M. Group Art Unit: 2141

Atty. Dkt No.: 1033-SS00379 Confirmation No.: 5754

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

In response to the Final Office Action mailed on November 14, 2005 (hereinafter, "the Final Office Action"), Applicants file herewith a Notice of Appeal and a Pre-Appeal Brief Request for Review. The Applicants request review of the following issues:

1. Claims 1-10 and 13-30 Are Allowable over RFC 2516 in View of Iwakata.

Applicants traverse the rejection of claims 1-10 and 13-30 under 35 U.S.C. §103(a) over RFC 2516 in view of U.S. Pat. Publication No. 2002/0095299 ("Iwakata") at page 3 of the Final Office Action. There is no suggestion or motivation to modify the cited references to make the asserted combination. Moreover, the asserted combination fails to disclose or suggest the particular arrangement of elements recited in the claims.

Claim 1 recites transmitting a point-to-point over Ethernet (PPPoE) active discovery request (PADR) packet in response to receiving the [active discovery offer] PADO packet, wherein the PADR packet includes a tag that specifically identifies a product model of the customer premises device. Claim 6 recites sending a point-to-point over Ethernet (PPPoE) active discovery packet, wherein the PPPoE active discovery packet includes a tag that specifically

CUSTOMER NO.
34456

identifies a product model of a customer premises equipment (CPE) device. Claim 16 recites receiving a point-to-point over Ethernet (PPPoE) active discovery packet, wherein the PPPoE active discovery packet includes a tag that specifically identifies a product model of a customer premises equipment (CPE) device. Claim 21 recites a customer premises equipment (CPE) device having a module configured to transmit a point-to-point over Ethernet (PPPoE) active discovery packet including a tag, the tag comprising a device identifier field that uniquely identifies a CPE product model. Claim 24 recites an access concentrator configured to receive an active discovery packet having a tag comprising a device identifier field, wherein the active discovery packet is arranged for transmission by a communications device capable of terminating a point-to-point connection, and wherein the communications device identifier field uniquely identifies a product model associated with the communications device.

Both the Non-Final Office Action (mailed January 25, 2005) and the Final Office Action (mailed November 14, 2005) failed to establish a *prima facie* case of obviousness, which requires:

- 1) there must be a suggestion or motivation to make the asserted combination, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art;
- 2) there must be a reasonable expectation of success; and
- 3) the alleged combination teach or suggest all the claim limitations.

See M.P.E.P. §2142. Applicants submit that there is no suggestion or motivation to make the asserted combination of RFC 2516 and Iwakata.

The Final Office Action asserts that RFC 2516 teaches a device identifier code that specifically identifies a product model of the CPE device, citing pages 3-4 and sections 4 and 5 of RFC 2516. *See Final Office Action*, p. 4, paragraph 3a. Applicants disagree. RFC 2516 discloses that a host performs discovery to identify an *Ethernet MAC address* of the device and to establish a PPPoE session identifier. *See RFC 2516*, p. 2, paragraph 3, "Protocol Overview." Applicants note that the Ethernet Media Access Control (MAC) address is a hardware address, not a product model. In the Appendix of RFC 2516 at page 8, Applicants note that a tag "AC-Name" may be provided to uniquely identify a particular Access Concentrator unit by a combination of Trademark, model and serial id information or simply by an UTF-8 rendition of the MAC address of the box." *See RFC 2516*, p. 8, Appendix A. The tag uniquely identifies the

CUSTOMER NO.
34456

access concentrator, but the customer premises equipment. Thus, while RFC 2516 describes the MAC address as different from the product model, it does so in the context of a particular Access Concentrator unit. RFC 2516 fails to disclose or suggest a tag that specifically identifies a product model of the customer premises equipment.

RFC 2516 discloses a standard method for transporting multiprotocol datagrams over point-to-point communications links. *See RFC 2516*, p. 1, Abstract. RFC 2516 describes how to build point-to-point (PPP) sessions and how to encapsulate PPP packets over Ethernet. *See RFC 2516*, p. 1, Abstract. Additionally, RFC 2516 discloses that point-to-point over Ethernet (PPPoE) has two distinct stages: a discovery stage and a PPP session stage. *See RFC 2516*, p. 2, paragraph 3, "Protocol Overview."

By contrast, Iwakata discloses a customer information control system for controlling personal information and product identification information of the electronic equipment belonging to a customer. *See Iwakata*, Abstract. The electronic equipment automatically reads out the product identification information from a product identification information storing unit and sends the product identification information to the host machine as the customer management information. *See Iwakata*, Abstract. Nowhere does Iwakata teach or suggest placing this information into a PADI packet including a tag. Moreover, the disclosure of Iwakata assumes that the PPP session has already been established, and fails to disclose or suggest involvement in the discovery phase. Therefore, RFC 2516 and Iwakata are directed to completely different issues. RFC 2516 and Iwakata fail to disclose or suggest a motivation to modify the discovery stage of RFC 2516 to use the produce identification information of Iwakata. The only motivation to make the asserted combination is provided by the disclosure of the present application.

Moreover, there is no reasonable expectation of success. In the discovery stage of RFC 2516, the host broadcasts an initiation packet, one or more access concentrators send an offer packet, the host sends a unicast session request packet, and the selected access concentrator sends a confirmation packet. *See RFC 2516*, p. 4, paragraph 5, "Discovery Stage." At this point, the host may proceed to a PPP Session stage. *See RFC 2516*, p. 4, paragraph 5, "Discovery Stage." RFC 2516 provides no indication that the Initiation packet can contain a tag based on the device identifier code or that an access concentrator is adapted to receive such a tag. Since

CUSTOMER NO.
34456

Iwakata is silent with regard to the Discovery stage, there is no reasonable expectation that the asserted combination of RFC 2516 and Iwakata would be successful.

Additionally, even if the asserted combination of RFC 2516 and Iwakata were made, the asserted combination of RFC 2516 and Iwakata fails to disclose or suggest at least one element of each of the independent claims. *See Response to Non-Final Office Action* mailed 4/25/2005, pp. 7-11. The asserted combination of RFC 2516 and Iwakata fails to disclose or suggest a tag that specifically identifies a product model of a customer premises device, during a discovery phase. The discovery phase discussion of RFC 2516 is directed to a Host and an Access Concentrator. *See RFC 2516*, p. 4, paragraph 5, "Discovery Stage." RFC 2516 fails to disclose or suggest a tag that specifically identifies a product model of a customer premises equipment device, and Iwakata is silent with respect to a discovery phase. Consequently, the Final Office Action fails to establish a *prima facie* case of obviousness with respect to each independent claim.

In view of the arguments presented above and presented in the *Response to Non-Final Office Action* mailed 4/25/2005, pp. 7-11 which is incorporated herein by reference, the asserted combination of RFC 2516 and Iwakata fails to disclose or suggest at least one element of each of the claims 1-10 and 13-30. Therefore, the rejection of claims 1-10 and 13-30 over the asserted combination of RFC 2516 and Iwakata is improper and should be withdrawn.

2. Claims 31-35 Are Allowable over RFC 2516, Iwakata and Owens

Applicants respectfully traverse the rejection of claims 31-35 under 35 U.S.C. §103(a) over RFC 2516, Iwakata, and U.S. Patent Pub. No. 2003/0053443 ("Owens"). As previously discussed, the asserted combination of RFC 2516 and Iwakata fails to disclose or suggest transmitting a point-to-point over Ethernet (PPPoE) active discovery request (PADR) packet in response to receiving the PADL packet, wherein the PADR packet includes a tag that specifically identifies a product model of the customer premises device, as recited in claim 1, from which claims 31-35 depend. Owens discloses a method of establishing a PPPoE connection using an Ethernet MAC address of the source device as the source address. *See Owens*, p. 6, paragraph 0076. Additionally, the user identifier retrieved from the client computer as shown in Figure 4 of Owens is "preferably the user's phone number." *See Owens*, p. 6, paragraph 0082. However, Owens fails to disclose a tag that specifically identifies a product

CUSTOMER NO.
34456

model of the customer premises device, as recited in claim 1. Thus, the asserted combination of RFC 2516, Iwakata and Owens fails to disclose or suggest at least one element of each of the dependent claims 31-35. Therefore, the rejection of claims 31-35 over RFC 2516, Iwakata and Owens should be withdrawn.

3. Claims 11-12 and 36 Are Allowable over RFC 2516, Iwakata, Owens and Koo.

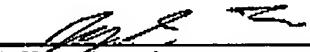
Applicants traverse the rejection of claims 11-12 and 36 under 35 U.S.C. §103(a) over RFC 2516, Iwakata, Owens, and U.S. Pat. Pub. No. 2005/0129002 ("Koo") at page 16 of the Office Action. Koo discloses a memory means of a DSL web-phone service apparatus for saving and managing an ID number and for transmitting the ID number. *See Koo, Abstract.* Koo fails to disclose or suggest sending a PPPoE active discovery packet that includes a tag that specifically identifies a product model of a customer premises equipment (CPE) device, as recited in claim 6. Therefore, in light of the arguments presented above, the asserted combination of RFC 2516, Iwakata, Owens and Koo fails to disclose at least one element of independent claim 6 and of claims 11-12 and 36, at least by virtue of their dependency from claim 6.

CONCLUSION

In light of the arguments presented above, the rejections of claims 1-36 are improper, and the Applicants respectfully request withdrawal of the rejections. The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account Number 50-2469.

Respectfully submitted,

1-3-2005
Date


Jeffrey G. Toler, Reg. No. 38,342
Attorney for Applicant
TOLER, LARSON & ABEL, L.L.P.
5000 Plaza On The Lake, Suite 265
Austin, Texas 78746
(512) 327-5515 (phone)
(512) 327-5452 (fax)